

January 8, 2024

*via ECF*

The Honorable Laura Taylor Swain  
Daniel Patrick Moynihan  
United States Courthouse  
500 Pearl St.  
New York, NY 10007-1312

RE: *True Return Systems LLC v. MakerDAO*, No. 22-cv-8478 (LTS)  
Our File: TRUE.220216.MAK

Dear Judge Swain:

This firm represents Plaintiff True Return Systems, Inc. (“TRS”). The purpose of this letter is to advise the Court of a decision by the USPTO’s Patent Trial and Appeal Board (“PTAB”) possibly having relevance to this action before the Court.

On January 5, 2024, the PTAB agreed to review TRS’s U.S. Patent No. 10,025,797 (the “’797 Patent”), which is the subject of TRS’s claims. *DeFi Education Fund v. True Return Systems, LLC*, IPR2023-01388, Paper No. 7 (P.T.A.B. January 5, 2024). As discussed below, TRS believes that the institution of the PTAB proceeding should have no bearing on the present action.

TRS brought the present action claiming infringement of its ‘797 Patent by MakerDAO, a distributed autonomous organization (“DAO”). (*See Comp.*, Dkt. 1). Motions are pending before the Court including TRS’s Motion for Recoupment of Costs and Fees (Dkt. No. 71) and MakerDAO’s Motion to Dismiss the Complaint (Dkt. No. 75), both of which have been fully briefed.

Separately, on January 5, 2024, the Patent Trial and Appeal Board (“PTAB”) granted a petition by non-party DeFi Education Fund to institute an *inter partes review* (“IPR”) of TRS’s ‘797 Patent. Plaintiff believes that the grant is in error and intends to vigorously challenge the proceeding. For the Court’s convenience, we submit herewith, as Exhibit A and B, respectively, copies of the Board’s decision and scheduling order.

In granting the petition, the PTAB has not made a substantive determination that any claim of the ‘797 Patent is invalid. Rather, the Board has only found that the petitioner made a threshold showing to proceed with the IPR:

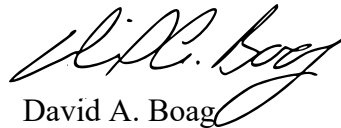
As noted by the PTAB in its decision: “Our factual findings and determinations at this stage of the proceeding are preliminary, and based on the evidentiary record

developed thus far. This is not a final decision as to the patentability of claims for which inter partes review is instituted. Our final decision will be based on the record as fully developed during trial.” IPR2023-01388, Decision, Paper No. 7.

*DeFi Education Fund v. True Return Systems, LLC*, IPR2023-01388, Paper No. 7 at 29 (P.T.A.B. January 5, 2024). *See also* 35 U.S.C. § 314(a); 77 Fed. Reg. at 7046 (describing the threshold as a “somewhat flexible standard that allows the judge room for the exercise of judgment”).

TRS does not believe that any action is required on the part of the Court and that the PTAB’s decision does not have any bearing on this action and the resolution of the motions presently before the Court.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D.A. Boag", written in a cursive style.

David A. Boag

Encl.

cc: All Counsel of Record (via ECF)